

1 ORRICK, HERRINGTON & SUTCLIFFE LLP
2 ANNETTE L. HURST (SBN 148738)
ahurst@orrick.com
3 DANIEL D. JUSTICE (SBN 291907)
djustice@orrick.com
4 The Orrick Building
405 Howard Street
San Francisco, CA 94105-2669
5 Telephone: +1 415 773 5700
Facsimile: +1 415 773 5759

6 DIANA M. RUTOWSKI (SBN 233878)
7 drutowski@orrick.com
1000 Marsh Road
8 Menlo Park, CA 94025
Telephone: +1 650 614 7400
9 Facsimile: +1 650 614 7401

10 [additional counsel appears on next page]

11
12 UNITED STATES DISTRICT COURT
13 NORTHERN DISTRICT OF CALIFORNIA
14 SAN FRANCISCO DIVISION

15
16 WILLIAMS-SONOMA, INC.,

Case No.: 18-cv-07548-EDL

17 Plaintiff,

**JOINT CASE MANAGEMENT
STATEMENT**

18 v.

Date: May 7, 2019

19 AMAZON.COM, INC.,

Time: 10:00 a.m.

20 Defendant.

Ctrm: E

Judge: Honorable Elizabeth D. Laporte

21
22 Complaint Filed: December 14, 2018

23

24

25

26

27

28

1 MARGARET WHEELER-FROTHINGHAM (*Pro Hac Vice*)
2 mwheeler-frothingham@orrick.com
3 51 West 52nd Street
4 New York, NY 10019-6142
5 Telephone: +1 212 506 5000
6 Facsimile: +1 212 506 5151

7 Attorneys for Plaintiff Williams-Sonoma, Inc.

8 DURIE TANGRI LLP
9 DARALYN J. DURIE (SBN 169825)
10 ddurie@durietangri.com
11 MARK A. LEMLEY (SBN 155830)
12 mlemley@durietangri.com
13 JOSEPH C. GRATZ (SBN 240676)
14 jgratz@durietangri.com
15 ALLYSON R. BENNETT (SBN 302090)
16 abennett@durietangri.com
17 217 Leidesdorff Street
18 San Francisco, CA 94111
19 Telephone: +1 415-362-6666
20 Facsimile: +1 415-236-6300

21 Attorneys for Defendant Amazon.com, Inc.

22
23
24
25
26
27
28

CASE MANAGEMENT STATEMENT AND RULE 26(F) REPORT

Pursuant to Federal Rule of Civil Procedure 26(f), Local Rule 16-9, and the Standing Order For All Judges of the Northern District of California, Plaintiff Williams-Sonoma, Inc. (“WSI”) and Defendant Amazon.com, Inc. (“Amazon”) (collectively, “the Parties”), by and through undersigned counsel, jointly submit this Joint Case Management Statement and Rule 26(f) Report.

1. JURISDICTION AND SERVICE:

This Court has subject matter jurisdiction over WSI’s Patent Act and Lanham Act claims pursuant to federal question jurisdiction, 28 U.S.C. §§ 1331, 1338. This Court has supplemental jurisdiction over the claims arising under California state law pursuant to 28 U.S.C. § 1337. No issues exist as to personal jurisdiction or venue. WSI served the Complaint and Summons on Amazon (ECF No. 12). Amazon has accepted service of the Complaint and has filed a motion to dismiss certain claims (ECF No. 23). No other parties remain to be served.

2. FACTS:

WSI began operating an online storefront under the name WILLIAMS-SONOMA in 1999, and it owns federal registrations covering its brand. WSI does not sell its products through Amazon. Despite the fact that WSI does not sell through Amazon, products are advertised, offered for sale, and sold under the WILLIAMS-SONOMA brand on Amazon.com.

WSI also sells items under its “west elm” brand, among others, and those items include its ORB chair, for which it also has a design patent (Patent No. D815452), and its SLOPE chair. Among the items Amazon has sold are the “Rivet Modern Upholstered Orb Office Chair” whose design has similarities to that of the west elm ORB chair, and a “Rivet Industrial Slope Top-Grain Leather Swivel Office Chair” whose design has similarities to that of the west elm SLOPE chair. WSI claims trademark rights in the terms ORB and SLOPE.

On December 14, 2018, WSI filed a Complaint alleging seven causes of action against Amazon based on the availability of certain items advertised, offered for sale, and sold under the WILLIAMS-SONOMA brand on Amazon.com and Amazon's sale of the Rivet Modern Upholstered Orb Office Chair and the Rivet Industrial Slope Top-Grain Leather Swivel Office

1 Chair. Those causes of action were for: (1) infringement of the '452 Patent, (2) federal
2 trademark infringement and trademark counterfeiting under Section 32(1) of the Lanham Act,
3 (3) federal trademark dilution of the WILLIAMS-SONOMA mark, (4) unfair competition under
4 Section 43(A) of the Lanham Act, (5) common law unfair competition/trademark infringement,
5 (6) dilution under California law, and (7) violation of California unfair competition law (ECF No.
6 1).

7 On February 5, 2019, Amazon filed a partial motion to dismiss. WSI opposed the motion
8 on February 26, 2019, and Amazon filed its reply on March 8, 2018. The Court heard oral
9 argument on April 2, 2019, and the motion remains under submission.

10 The principal disputed factual issues concern alleged: patent infringement, trademark
11 counterfeiting, trademark infringement, trademark dilution, unfair competition, willfulness, and
12 damages.

13 || 3. **LEGAL ISSUES:**

14 The Parties identify the following disputed points of law at this time:

- Whether Amazon has infringed the '452 Patent (35 U.S.C. § 271);
- Whether Amazon has used a counterfeit of WSI's registered WILLIAMS-SONOMA service mark in connection with online retail services (15 U.S.C. § 1114(1));
- Whether Amazon has used the WILLIAMS-SONOMA mark in a manner likely to cause confusion as to the affiliation, connection, or association between Amazon and WSI, or as to the origin, sponsorship, or approval of the sale of WSI's goods, retail services, or commercial activities via Amazon.com (15 U.S.C. § 1125(a));
- Whether Amazon has used the WILLIAMS-SONOMA mark in a manner that has diluted the mark (15 U.S.C. § 1125(c); Cal. Bus. & Prof. Code § 14200 *et seq.*);
- Whether Amazon has infringed any rights of WSI in SLOPE and ORB, which WSI claims are common law trademarks;
- Whether Amazon has engaged in unfair competition (15 U.S.C. § 1125(a); Cal. Bus. Prof. Code § 17200, *et seq.*);

- Whether Amazon's actions were willful;
- Whether WSI is entitled to compensation for any proven trademark counterfeiting, trademark infringement, trademark dilution, patent infringement, or unfair competition, and if so, the amount;
- Whether WSI is entitled to injunctive relief (15 U.S.C. § 1116; 35 U.S.C. § 283);
- Whether any Party is entitled to statutory damages for use of a counterfeit mark, treble damages, attorneys' fees, and costs, and if so, the amount (15 U.S.C. § 1117; 35 U.S.C. § 285).

4. MOTIONS:

10 On February 5, 2019, Amazon filed a motion to dismiss WSI's Complaint (ECF No. 23).
11 The motion was heard on April 2, 2019 (ECF No. 30). The motion is currently pending before
12 the Court. There are no other prior or pending motions. The Parties anticipate filing motions for
13 summary judgment and/or summary adjudication after discovery in accordance with the proposed
14 case schedule.

5. AMENDMENT OF PLEADINGS:

16 WSI expects to amend its Complaint to add claims for infringement of at least U.S. Patent
17 No. D836,823 and U.S. Patent No. D836,822, pursuant to 35 U.S.C. § 271. Both patents issued
18 after WSI filed its Complaint. The Parties propose a deadline of thirty days to amend the
19 Complaint after the Court enters its order ruling on Amazon’s motion to dismiss, but this proposal
20 is not intended to supersede any deadlines to amend set by Court order on the motion.

6. EVIDENCE PRESERVATION:

22 The Parties have reviewed the Guidelines Relating to the Discovery of Electronically
23 Stored Information and the Checklist for ESI Meet and Confer and hereby certify that they have
24 met and conferred pursuant to Fed. R. Civ. P. 26(f) regarding reasonable and proportionate steps
25 taken to preserve evidence relevant to the issues reasonably evident in this action. Each Party
26 represents that it has instituted reasonable document retention procedures so as to maintain any
27 relevant documents, electronic or otherwise, or any other relevant electronically recorded
28 material, until this dispute is resolved. The Parties have agreed to metadata fields to be produced

1 with ESI. The Parties are not aware of any other particular ESI issues that may arise in this case,
 2 but will address those to the Court if they do arise and cannot be resolved by the Parties.

3 **7. DISCLOSURES:**

4 WSI and Amazon agree to exchange initial disclosures pursuant to Federal Rule of Civil
 5 Procedure 26(a) on April 30, 2019.

6 **8. DISCOVERY:**

7 The Parties have not yet served discovery requests. The Parties anticipate the scope of
 8 discovery will encompass the factual and legal issues identified in Sections 2 and 3 above, and the
 9 requested relief identified in Section 11 below, including all related, ancillary, and subsidiary
 10 factual and legal issues and matters.

11 The Parties have alternate proposals regarding the number of depositions needed:

- 12 • WSI anticipates needing to take early 30(b)(6) depositions to discover how
 13 Amazon generates, configures, and displays content on the Amazon platform and
 14 in its advertising as well as how Amazon develops its own private label products.
 15 Understanding how the Amazon platform operates at the outset will facilitate
 16 discovery into the substantive aspects of this case. Given the complexity of this
 17 case and the causes of action involved, WSI believes that it will need four days of
 18 30(b)(6) testimony beyond the ten depositions provided under the Rules to
 19 conduct effective discovery. WSI proposes that the Fed. R. Civ. Proc.
 20 30(a)(2)(a)(i) ten-deposition limit apply only to fact witnesses, and that in
 21 addition, each Party may take four days of Fed. R. Civ. Proc. 30(b)(6) depositions.
 22 • Amazon disagrees and proposes that each Party may take two days of Fed. R. Civ.
 23 Proc. 30(b)(6) depositions and that the Fed. R. Civ. Proc. 30(a)(2)(a)(i) ten-
 24 deposition limit still apply.

25 The Parties agree to a limit of 30 interrogatories per side in light of the need to serve
 26 contention interrogatories relating to the patent claim.

27 The Parties otherwise agree to abide by the limitations on discovery as set forth by the
 28 Federal Rules of Civil Procedure.

1 The Parties have agreed to use the Northern District of California's "Model Protective
 2 Order for Litigation Involving Patents, Highly Sensitive Confidential Information and/or Trade
 3 Secrets," which they intend to revise and submit by May 7, 2019.

4 The Parties are considering the Northern District of California's "Model Stipulated Order
 5 Re Discovery of Electronically Stored Information."

6 There are no discovery disputes at this time.

7 **9. CLASS ACTION:**

8 This litigation is not a class action.

9 **10. RELATED CASES:**

10 There are no related cases to this litigation.

11 **11. RELIEF:**

12 WSI respectfully requests that the Court enter judgment in its favor and award the
 13 following relief:

- 14 • Judgment that Amazon willfully infringed the '452 patent;
- 15 • Judgment that Amazon has willfully infringed and counterfeited WSI's registered
 WILLIAMS-SONOMA Mark;
- 16 • Judgment that Amazon has diluted WSI's famous WILLIAMS-SONOMA Mark;
- 17 • Judgment that Amazon has committed unfair competition in violation of the
 Lanham Act and state law;
- 18 • Judgment that Amazon has committed common law trademark infringement in
 violation of the Lanham Act and state law;
- 19 • Judgment that Amazon has committed false endorsement in violation of the
 Lanham Act;
- 20 • Judgment that Amazon has competed unfairly with WSI in violation of WSI's
 rights under California law;
- 21 • A permanent injunction enjoining Amazon from making, using, selling, or
 offering to sell its infringing goods;
- 22 • A permanent injunction enjoining Amazon from using the WILLIAMS-

SONOMA mark in conjunction with its online retail services and otherwise infringing or diluting WSI's marks;

- Damages, exemplary damages and disgorgement of profits in an amount to be proven at trial;
- Enhancement of damages including treble damages required to be awarded for trademark counterfeiting;
- Statutory damages of up to \$2,000,000 per counterfeit mark per type of goods sold by Amazon.
- A declaration that this is an exceptional case;
- Full costs, attorneys' fees, and pre- and post-judgment interest to the full extent permissible by law; and
- Such other and further relief as the Court deems just and proper.

Amazon does not seek monetary damages at this time. It reserves the right to respond to any damages calculation WSI may present.

12. SETTLEMENT AND ADR:

In accordance with ADR Local Rule 3-5, counsel for the Parties met and conferred regarding ADR options on April 16, 2019. WSI indicated its preference for a magistrate judge. Amazon wishes to defer a decision on whether to proceed before a magistrate judge or a private mediator until later in the case, when the scope of WSI's claims and the issues in this litigation become clearer. The scope of WSI's claims and issues in this case cannot be determined with any specificity now, because Amazon's motion to dismiss is pending, and WSI has indicated it intends to amend its Complaint.

13. CONSENT TO MAGISTRATE JUDGE FOR ALL PURPOSES:

The Parties have consented to Magistrate Judge Laporte to conduct all proceedings including trial and entry of judgment (ECF Nos. 20 & 21).

14. OTHER REFERENCES:

The Parties do not believe the case is suitable for reference to binding arbitration, a special master, the Judicial Panel on Multidistrict Litigation, or any other reference.

15. **NARROWING OF ISSUES:**

2 The Parties do not presently believe that the issues can be narrowed by suggestions to
 3 expedite the presentation of evidence at trial or bifurcate of issues, claims, or defenses.

16. **EXPEDITED TRIAL PROCEDURES:**

5 The Parties do not presently believe that this case can be handled on an expedited basis
 6 with streamlined procedures.

17. **SCHEDULING:**

8 The Parties propose two alternate case schedules:

Event	WSI's Proposed Completion Date	Amazon's Proposed Completion Date
Rule 26(a)(1) disclosures	April 30, 2019	Same
Initial CMC	May 7, 2019	Same
Fact Discovery Cutoff	February 10, 2020	Same
Exchange of Initial Expert Reports	February 28, 2020	March 13, 2020
Exchange of Rebuttal Expert Reports	March 27, 2020	April 10, 2020
Expert Discovery Cutoff	April 10, 2020	May 1, 2020
Filing of MSJs	April 17, 2020	May 29, 2020
Filing of Objection to MSJs	May 8, 2020	June 26, 2020
Filing of Reply ISO MSJs	May 20, 2020	July 17, 2020
MSJ Hearing	June 9, 2020	August 4, 2020
Pretrial Conference	June 23, 2020	August 25, 2020
Trial Date	July 6, 2020	September 14, 2020

18. **TRIAL:**

20 WSI has made a demand for a jury trial. The Parties anticipate that trial will last 10 court
 21 days, not counting jury selection.

19. **DISCLOSURE OF NON-PARTY INTERESTED ENTITIES OR PERSONS:**

22 The Parties have both filed their Certification of Interested Entities or Persons as required
 23 by Civil Local Rule 3-15. Plaintiff WSI represented that it does not have a parent corporation and
 24 that BlackRock, Inc., a publicly held corporation, owns ten percent (10%) or more of WSI's
 25 stock. Amazon represented that it does not have a parent corporation and no publicly held
 26 stock.

1 corporation owns ten percent (10%) or more of Amazon's stock.

2 **20. PROFESSIONAL CONDUCT:**

3 All attorneys of record have reviewed the Guidelines for Professional Conduct for the
4 Northern District of California.

5 **21. OTHER:**

6 There are no other issues to report at this time.

7
8 Dated: April 30, 2019

ORRICK, HERRINGTON & SUTCLIFFE LLP

9
10 By: /s/ Diana M. Rutowski
11 DIANA M. RUTOWSKI

12 Attorney for Plaintiff Williams-Sonoma, Inc.

13
14 *I, Diana Rutowski, am the ECF user whose ID and password are being used to file this*
15 *Joint Case Management Statement. In compliance with General Order 45, X.B., I hereby attest*
that Joseph C. Gratz has concurred in this filing.

16
17 Dated: April 30, 2019

DURIE TANGRI LLP

18
19 By: /s/ Joseph C. Gratz
JOSEPH C. GRATZ

20 Attorney for Defendant Amazon.com, Inc.

CERTIFICATE OF SERVICE

I, Diana Rutowski, certify that on the 30th day of April 2019, I caused the foregoing document to be electronically transmitted to the Clerk of the Court using the ECF System for filing and transmittal of a Notice of Electronic Filing to the ECF registrants and attorneys of record in this case.

/s/ Diana M. Rutowski
DIANA M. RUTOWSKI